

REMARKS

Claims 1-13 and 15-20 are presented for examination.

A typo in claim 12 has been corrected to address the Examiner's objection.

Claims 1-13 and 15-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Watkins in view of Hansen. This rejection is respectfully traversed for the following reasons.

Claim 1 recites a data processing system operable with at least two types of software. The system comprises:

- a host interface for providing address, data and control signals from a host,
- a storage element for holding data accessible via the host interface, and
- alternate access circuitry for providing access to the storage element so as to access the data as a first data element in a first register when the system operates with a first type of software, and as a second data element in a second register when the system operates with a second type of software.

Hence, claim 1 requires accessing the data held in the storage element as a first data element in a first register when the system operates with a first type of software, and accessing the same data as a second data element in a second register when the system operates with a second type of software.

The Examiner holds Watkins to differ from the claimed invention only in that the reference does not disclose the claimed alternate access circuitry for providing access to the storage element so as to access the data as a first data element in a first register when the system operates with a first type of software, and as a second data element in a second register when the system operates with a second type of software.

Hansen is relied upon for disclosing the alternate access circuitry.

In the application of a rejection under 35 U.S.C. § 103, it is incumbent upon the Examiner to factually support a conclusion of obviousness. As stated in *Graham v. John Deere Co.* 383 U.S. 1, 13, 148 U.S.P.Q. 459, 465 (1966), obviousness under 35 U.S.C. §103 must be determined by considering (1) the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; and (3) resolving the level of ordinary skill in the pertinent art.

However, as clear from the Examiner's rejection, the Examiner has failed to ascertain the differences between the prior art and the claims in issue.

In particular, Hansen discloses a virtual memory system that translates a task specific virtual address into a generalized virtual address, and translates the generalized virtual address into a physical address (col. 2, lines 45-51, col. 4, lines 45-57). The Examiner did not point out specifically wherein the reference discloses accessing the data held in the storage element as a first data element in a first register when the system operates with a first type of software, and accessing the same data as a second data element in a second register when the system operates with a second type of software.

It is respectfully submitted that Hansen does not teach or suggest these features. As the Examiner admits, Watkins also does not disclose providing access to the storage element so as to access the data as a first data element in a first register when the system operates with a first type of software, and as a second data element in a second register when the system operates with a second type of software.

Accordingly, a combination of Watkins with Hansen is not sufficient to suggest the claimed alternate access circuitry for providing access to the storage element so as to

access the data as a first data element in a first register when the system operates with a first type of software, and as a second data element in a second register when the system operates with a second type of software, as claim 1 requires.

It is well settled that the test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985). In determining whether a case of *prima facie* obviousness exists, it is necessary to ascertain whether the prior art teachings appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification. *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

As shown above, the reference combination applied by the Examiner is not sufficient to arrive at the invention recited in claim 1.

Independent claim 15 recites a network interface comprising:

- a host interface for supplying address, data and control signals from a host,
- storage element for holding a data element accessible via the host interface, and
- alternate access circuitry coupled to the storage element for providing multiple paths for accessing the data element, and configured to select a path for accessing the data element depending on a type of software used to operate the network interface.

The Examiner contends that Watkins discloses alternate access circuitry coupled to the storage element for providing multiple paths for accessing the data element. However, the Examiner admits that Watkins does not disclose selecting a path for accessing the data element depending on a type of software used to operate the network interface.

Hansen is relied upon for disclosing selecting a path for accessing the data element depending on a type of software used to operate the network interface. However, the Examiner has failed to point out specifically wherein Hansen discloses these features.

It is respectfully submitted that no alternate access circuitry configured to select a path for accessing the data element depending on a type of software used to operate the network interface is found in Hansen.

Moreover, one skilled in the art would understand that Hansen cannot teach these features, because as the Examiner admits, Hansen does not disclose alternate access circuitry coupled to the storage element for providing multiple paths for accessing the data element in the storage element.

As demonstrated above, the applied combination of references is not sufficient to suggest the claimed alternate access circuitry configured to select at least one of multiple paths for accessing the data element depending on a type of software used to operate the network interface.

Independent claim 18 amended to more clearly define the claimed invention recites a method of providing access to a storage element for holding a data element, comprising the steps of:

- accessing the data element via a first access path when a first type of software is used to operate the data processing system, and

- accessing the data element via a second access path when a second type of software is used to operate the data processing system.

The Examiner did not address the steps recited in claim 18. However, as demonstrated above, neither Watkins nor Hansen discloses accessing the data element via

a first access path when a first type of software is used to operate the data processing system, and accessing the same data element via a second access path when a second type of software is used to operate the data processing system.

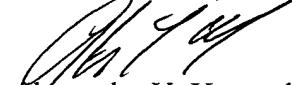
Claims 2-13, 16-17 and 19-20 respectively dependent from claims 1, 15 and 18 are defined over the prior art at least for the reasons presented above.

In view of the foregoing, and in summary, claims 1-13 and 15-20 are considered to be in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Alexander V. Yampolsky  
Registration No. 36,324

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
(202) 756-8000 AVY:  
Facsimile: (202) 756-8087  
**Date: March 2, 2004**